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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/751,614
Filing Date: January 05, 2004
Appellant(s): OLIVER, TERRANCE W.

Chad W. Miller
For Appellant

EXAMINER'S ANSWER

MAILED

SEP 20 2006

GROUP 2800

This is in response to the appeal brief filed 6/5/2006 appealing from the Office action mailed 11/2/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,166,502	Rendleman et al.	11-1992
6,059,659	Busch et al.	05-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 21, 23, 24, 26-28 and 30-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rendleman et al. (US 5,166,502) in view of Busch et al. (US 6,059,659).

Re claim 21: For the sake of clarity, the limitations of claim 21 are listed below in italics, followed in each case by a discussion of the pertinent prior art teachings.

A gaming chip for use in a bet in a casino game, the gaming chip comprising:

Rendleman et al. is directed (column 1, lines 10-17) to a gaming chip for use in a casino game.

a transponder;

a memory located within the transponder;

The electronic and transponder aspects of the gaming chip is summarized at column 2, line 50 to column 3, line 10. Rendleman et al. notes, “each transponder has a unique code in alternating octal hex, an equivalence of 32 bits, resulting in thirty-four billion possible combinations.” Thus there is a transponder having memory on it.

a data field in said memory, wherein an identification identifying a first class for the gaming chip is located in said data field;

a game denominational value contained in the transponder;

Rendleman et al. teaches that a variety of designations identifying different kinds of chips are present (column 3, lines 1-5): “Information to be encoded may consist of, but is not limited to, casino designation, denominational chip value, serial number and date of issue.”

Game denomination value is explicitly claimed. Whether the limitation of a class designation is met depends on whether such information as ‘casino designation’ is understood to be a class of chip. Based on a more narrow interpretation in light of the specification, ‘class of chip’ can be interpreted to be a ‘promotional’ or ‘side-bet’ type of designation. For this interpretation, Busch et al. will be used below to show the value of having ‘special chips’ for certain games.

wherein the identification differentiates the first class gaming chip from at least one other class of gaming chips when said first class gaming chip and said at least one other class of gaming chips are intermingled within said bet,

The Examiner notes that Rendleman et al. does not explicitly teach intermingling different types of chips in the same bet: he particularly suggests use in a slot machine (column 4, line 38). But the claim is not directed to a method of using a chip, but merely to the chip itself.

Art Unit: 2876

The intermingling of chips in the same bet is an intended use and not a structural difference between the claimed invention and the prior art. The fact is that the chips as taught by Rendleman et al. are structurally capable of responding to transponder signals and different chips, even when placed in proximity to each other, would respond differently, based on the different type of data stored on the chip.

the transponder transmitting said game denominational value and said identification in response to a received signal, wherein each of said gaming chips of said at least one other class includes a data field within a memory of said other class of gaming chips.

Rendleman et al. teaches (column 4, lines 35-38): “In use, the transponder is electrically stimulated by a reading device which causes the electronic transponder to transmit the information stored in it.” As has already been shown Rendleman et al. teaches (column 3, lines 1-5) that the chip has on it such data as “casino designation, denominational chip value, serial number and date of issue.” Thus, all of this information is yielded during query by the reader, and chips (including chips that are together) can be differentiated in a variety of ways.

If ‘class of chip’ is interpreted to be a ‘promotional’ or ‘side-bet’ type of designation as could be understood in light of the specification, then Rendleman et al. is deficient in this regard. Rendleman et al. differentiates chips in a variety of ways but not in this way.

Art Unit: 2876

Busch et al. teaches (column 6, especially lines 1-10), “progressive chips” which are a separate category of chips. In at least one form (column 6, lines 20-30), these progressive / non-value chips are not the same as those used to place the standard bets.

In view of Busch et al.’s teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to accommodate Rendleman et al.’s chip technology to Busch’s “progressive chips” because that way the house can have an easier time managing many complex side-bets. Rendleman et al. already shows that chips (whether intermingled in a bet or not – this is intended use) can be differentiated from one another in a variety of ways: “casino designation, denominational chip value, serial number and date of issue.” Distinguishing progressive chips is simply one more designation, and Busch shows the value of distinguishing chips in this way.

Re claims 23, 24, 26-28, 30, 36, 37: The limitations of these claims have been addressed with respect to claim 21 above. Claim 21 has been broken out exactly above, for the sake of clarity.

Regarding specifically claims 27 and 28, special attention is given to these claims because they are written as apparatus claims. The Examiner notes, however, that the claims do not recite that two different classes of chips must be played in a common betting area of a gaming table. Rendleman et al. teaches (column 4, lines 35-38) that a reader may be placed in a slot machine. This is in accord with the language of claims 27 and 28, because the ‘common betting area’ may be the slot machine, and chips which are played sequentially in a slot machine

are differentiated from one another. In fact, slot machines typically permit multiple chips to be played as part of the same bet.

The word “table” appears nowhere in the language of the claims. The embodiment where the ‘common betting area’ is a slot machine is not precluded.

Re claim 31, 32: Busch teaches (column 1, lines 36-37): “A different chip color may be assigned to each player.” When taken with Rendleman et al.’s teaching (column 3, lines 1-5) that “Information to be encoded may consist of, but is not limited to, casino designation, denominational chip value, serial number and date of issue” it is would have been obvious to add player identification as just one more of many pieces of data encoded on the chip, for reasons already discussed above.

Re claims 33/34: Both denomination and non-denomination information are included as part of the data of Rendleman et al.’s chips, as column 3, lines 1-5 make clear.

Re claim 35, 38, 39: As the discussion re claim 21 makes clear, it would have been obvious to modify Rendleman et al.’s chip having a variety of transponder data to include promotional classes, as shown by Busch, for motivations already discussed above.

Re claim 40: Rendleman et al. teaches (column 3, lines 50-60) that different chips are distinct visually. This visual distinction can extend to any further chip distinctions such as achieved by modifying Rendleman et al. in view of Busch.

(10) Response to Argument

The Examiner attempts below to answer in order each argument raised by the Appellant. But firstly, the Examiner wishes to note that Rendleman et al. actually comes much closer than the Appellant acknowledges to teaching the every limitation of independent claims 21, 27, 28 and 36, for two reasons.

First, Rendleman et al. teaches that a variety of distinctive information, beyond merely denominational value, is stored on the gaming chip. Rendleman et al. teaches (see column 2, line 68 to column 3, line 5): “Each transponder has a unique code in alternating octal hex, an equivalence of 32 bits, resulting in thirty-four billion possible combinations. Information to be encoded may consist of, but is not limited to, *casino designation, denominational chip value, serial number* and date of issue.”

Thus, in reality, in Rendleman et al. the gaming chips can be distinguished among one another in more than one way; denomination and casino designation for example could be considered as two different ways of distinguishing chips.

If one wishes to take a broad interpretation of the term “class of gaming chip” then class could be considered ‘casino designation’ and the limitation is indeed met that chips can be distinguished by both denomination and an additional class.

Based on more narrow interpretation made by the Examiner in light of the specification, ‘class of chip’ was interpreted to be a ‘promotional’ or ‘side-bet’ type of designation, for which

Busch et al. was used merely to show the value of having ‘special chips’ for certain games. Given that Rendleman et al. has already opened the door for having a variety of transponder-based designations of game chip beyond denomination (column 2, line 68 to column 3, line 5 and elsewhere) Busch et al. clearly shows the usefulness of additional chip designations on the transponder, by showing games where they are used.

Second, limitations the limitation “... identification differentiates the first class gaming chip from at least one other class of gaming chips when said first class of gaming chip and said at least one other class of gaming chip *are intermingled in the same bet*” is actually an intended use limitation because the claims all are for a gaming chip and not a method of intermingling chips. **The intermingling of chips in the same bet is an intended use and not a structural difference between the claimed invention and the prior art.**

It is fully acknowledged that neither Rendleman et al. nor Busch et al. directly teach intermingling of a different class of chip in the same bet, but the fact is that the chips as taught by Rendleman/Busch are structurally capable of responding to transponder signals to differentiate between chips in a variety of ways, including a class of chip, whether class of chip is defined broadly or narrowly.

The crucial question of patentability hinges on whether the prior art chips structurally meet the limitations of the claim, not how the prior art chips are used. The use of the prior art chips matters only to the extent that they affect the structure. The Rendleman/Busch chips (with emphasis mainly on the primary teachings of Rendleman) clearly teach all of the claimed structure. **No method claims are present, and thus the question of whether the chips are**

actually intermingled in Rendleman/Busch (as opposed to being capable of being intermingled) is not important. The proper question is, would the chips be distinguishable from one another ***if*** they were intermingled in the same bet? The answer indeed is yes.

Now the Examiner attempts to address individually each of the arguments raised by the Appellant. The first argument, raised on pages 12 and 13, is that a Rendleman/Busch fails to address the situation of a single location where a bet is intermingled. The Appellant states, (page 13, lines 20-21), "Thus, there is no teaching or suggestion of a single betting location where an intermingled bet may be made."

Again, as noted above, the language of the claims are ***not*** for a method betting, but for a chip (independent claims 21 and 36), and any intermingling falls in the realm of intended use. Apparatus claims 27 and 28 also do not require intermingling

The question is not, are the chips intermingled in a single bet; but could they be intermingled. The answer clearly is yes, because Rendleman's chips respond with the particular identifying information stored on them, and this information will be different for different chips. Rendleman et al. (column 4, lines 35+): "In use, the transponder is electrically stimulated by a reading device which causes the electronic transponder to transmit the information stored in it." As column 3, lines 1-5 have shown, each chip has its own set of unique identifying information, so intermingling the chips in a single bet would be easily facilitated.

Busch is being used only to show that a progressive or promotional class is just one more way to distinguish among chips, in addition to the numerous ways (casino designation, denominational chip value, serial number and date of issue) already present in Rendleman et al.

In this sense, the modification is merely adding one more way of distinguishing, in addition to the several already present.

Also on page 13, the Appellant argues, “It is of further interest to note that the inclusion of the encoded electronic device is minimized in the Rendleman et al. disclosure as a part of the invention. See Rendleman et al. column 2, lines 56-61. While this does not eliminate the teaching of an encoded electronic device as part of the Rendleman et al. gaming chip, it clearly negates the existence of any suggestion or motivation for its use as a reference against the claims on appeal.”

The Examiner disagrees. Rendleman et al. has merely touched upon another separate embodiment. The existence of another embodiment could not possibly negate the use of a reference. No legal basis exists for such logic. Furthermore, the configuration of the chip with the transponder is discussed in detail in Rendleman; this embodiment is in no way minimized.

The Appellant has further argued, on page 14 of the Appeal Brief, that Busch et al. teaches away because he shows separate betting areas. However, it is not Busch’s teachings regarding table layout that are important; Busch is used to show promotional chips are yet another source of variability in chips, in addition to denomination, casino designation, and the other variations already present in Rendleman. Indeed, as has been noted, **nowhere do the claims even recite a table-type layout** and thus a ‘betting area’ could be the slots embodiment of column 4, lines 35-40 of Rendleman et al.

The Appellant has argued on page 15 that the Examiner indicated certain allowable subject matter that is now rejected. The Examiner notes, in response, that while allowability was indeed withdrawn, the Examiner had made the earlier mistake of reading the claims too narrowly, including reading the specification into the claims. The fact of intermingling in a common bet is not a feature, as the claims are not method claims; instead, it is an intended use. Thus, the question the Examiner should have asked is, are the chips *capable* of being differentiated if they were intermingled. The Examiner had previously referred to “progressive bets and primary bets in the same pile” but this is not in the language of the claims. Thus, withdrawal of allowability indication was proper.

The Appellant argues on page 16 of the Appeal Brief that a motivation is lacking. The Examiner disagrees and points out that very use of different promotional classes of chips in Busch is evidence that it is useful to distinguish among chips in this way. This provides motivation enough to add this distinction to the list of distinctions among chips already present in Rendleman et al., namely casino designation, denominational chip value, serial number and date of issue.

The Appellant has further questioned, on the bottom of page 16 and at the top of page 17, the Examiner’s characterization of the modification to include class information on the chip as ‘simple.’ The Examiner notes that this is in fact an important question, because the second prong of the Graham v. Deere test is, “Ascertaining the differences between the prior art and the claims at issue.” On this point, the Examiner maintains his stance noting that (column 2, line 68 to

column 3, line 5 of Rendleman et al.) “Each transponder has a unique code in alternating octal hex, an equivalence of 32 bits, resulting in thirty-four billion possible combinations. Information to be encoded may consist of, **but is not limited to**, casino designation, denominational chip value, serial number and date of issue. “ Based on how the bits are defined, a variety of information including class can be encoded. As the above excerpt shows, the Rendleman et al. chip leaves room for just this type of modification.

The Appellant also argues, on page 18, again that there is no motivation to include class of chip, except in the present invention. The Examiner disagrees and notes that Busch differentiates among a class of casino chip, and shows the usefulness of different classes of casino chip. This is the basis for adding this level of chip differentiation to the various differentiations already present in Rendleman et al. One need not look to the Instant Invention to arrive at this conclusion.

At the bottom of page 18, the Examiner weighs the obviousness of intermingling bets on a table to save table space. This is an argument that the Examiner did not even need to make (and perhaps should not have, because it confuses the issue) because the claims nowhere state that a table – type betting configuration is used. Multiple chips can also be used in a single slots bet, an arrangement that is more apropos for Rendleman et al., who specifically recites slot machines.

As for Appellant's arguments on pages 20 and 21, the Examiner must again clearly distinguish between (i) capability to be distinguished in an intermingled environment and (ii) actual intermingling of the chips. The claims require (i), not (ii).

Regarding the Appellant's arguments on page 21 regarding US 6,186,895, the Examiner notes that the allowance of the earlier patent is not any reason for allowance of the instant claims. For one thing, the claims in the earlier case are different. Second, and very importantly, those claims are method and system claims, not claims to a chip or an apparatus including chips. In any event, if the allowable subject matter of the two patents were the same, the issue of double patenting would have to be raised. The Examiner does not consider this to be the case.

Regarding the Appellant's contention on page 22 that claim 28 necessitates two different types of signals, the Examiner disagrees. There is nothing in the language of the claim that precludes the first chip from also conveying class information (even if it is just a null value). If this is so, then both chips can convey the same type of signal.

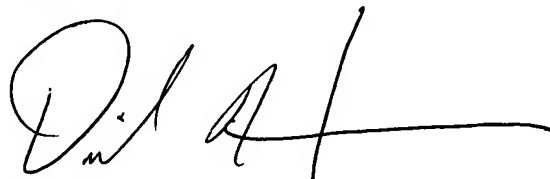
As for the Appellant's issue raised with claims 31 and 32, Busch teaches (column 1, lines 36-37): "A different chip color may be assigned to each player." When taken with Rendleman et al.'s teaching (column 3, lines 1-5) that "Information to be encoded may consist of, but is not limited to, casino designation, denominational chip value, serial number and date of issue" it is would have been obvious to add player identification as just one more of many pieces of data encoded on the chip, for reasons already discussed above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.


For the above reasons, it is believed that the rejections should be sustained.

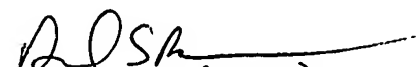
Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. A. Hess', with a long horizontal stroke extending to the right.

Daniel A. Hess, Examiner

Conferees:

Jared Fureman 


David Blum (TAVAS)